



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/705,344 | 11/10/2003 | Hidehiro Saho | 36261 | 5170 |
| 116 | 7590 | 07/06/2005 | EXAMINER | |
| PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108 | | | GEHMAN, BRYON P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3728 | |

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SA

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/705,344 | Applicant(s) SAHO, HIDEHIRO | |
| | Examiner Bryon P. Gehman | Art Unit 3728 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election without traverse of species II in the paper filed May 25, 2005 is acknowledged.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3 and 7 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 3, lines 4-5, the phrase "tape-like" is indefinite, as it is unclear in what manner and degree such is "like" a tape. See also lines 8, 10, 12, 14, 15, 17, 19, 20, 22, 23, 24, 25, 27, 28 and 30. Merely eliminating the "-like" in each instance is suggested.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 3 and 7 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Hikita (6,404,181). Hikita discloses an electronic part supplying tape (composed of plural elements 2, see column 5, lines 47-53 and Figure 3) used in a tape feeder (41) arranged in a part supplying portion of an electronic part mounting apparatus (all of Figure 7) for holding electronic parts on a tape member at a constant pitch and for

supplying the electronic parts comprising a first connecting portion (12, 12) formed on a first end portion of a first tape member (first series of elements 2), a second connecting portion (14, 14) formed on a second end portion of the first tape member to be connected to a first connecting portion formed on a first end of a second tape member (second series of elements 2 connected to the first series), an alignment means and a holding means (interengaging portions of the connecting portions, the pronged portion of 12 that aligns the first and second tape members in longitudinal, width and thickness directions of the tape members).

As to claim 7, a reel (41 or 43) is disclosed with the tape wound around it.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hikita ('181) in view of Busler (3,431,548). Hikita discloses an electronic part supplying tape comprising a first connecting portion (one end of a series of elements 2), and a second connecting portion (another end of a series of elements 2), an alignment means (interengaging portions of the connecting portions, the pronged portion of 12 that aligns the first and second tape members in longitudinal, width and thickness directions of the tape members), and a holding means (interengaging portions of the connecting

Art Unit: 3728

portions). Busler discloses a first connecting portion (at 44), and a second connecting portion (at 46), an alignment means (43, 44 and 48), and a holding means (44 and 46).

To modify the tape of Hikita employing the connecting structure of Busler would have been an obvious substitution of connecting, aligning and holding structures already known in the art, the advantages of connecting and aligning being described by Busler.

As to claim 7, a reel (41 or 43) is disclosed by Hikita with the tape wound around it.

8. Claim 3 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over DE 3311634 in view of Busler. DE 3311634 discloses an electronic part supplying tape comprising a first connecting portion (one end of 12), and a second connecting portion (another end of 12), an alignment means (interengaging portions of the connecting portions), and a holding means (interengaging portions of the connecting portions). Busler discloses a first connecting portion (at 44), and a second connecting portion (at 46), an alignment means (43, 44 and 48), and a holding means (44 and 46). To modify the tape of DE 3311634 employing the connecting structure of Busler would have been an obvious substitution of connecting, aligning and holding structures already known in the art, the advantages of connecting and aligning being described by Busler.

9. Applicant's arguments filed May 25, 2005 have been fully considered but they are not persuasive. Hikita, Busler and DE 3311634 are still pertinent to the claimed subject matter as described above.

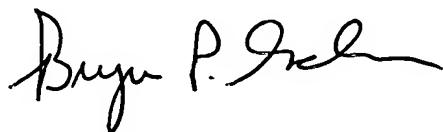
10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 5:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306 until July 14, 2005, and will become 571-273-8300 thereafter.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG